

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Frans TUOMELA et al.
Title: METHOD FOR REDIRECTING
CONTACTS AND SETTING UP
REDIRECTION
Appl. No.: 10/645208
Filing Date: 08/21/2003
Examiner: Marisol Figueroa
Art Unit: 2617
Confirmation Number: 7232

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents
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Examiner:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow. Claims 1-16 are now pending in this application.

I. Rejection of Claims 1, 2, 4, 7, 10-12, and 16 under 35 U.S.C. § 103(a)

In section 4 of the Office Action, Claims 1, 2, 4, 7, 10-12, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,031,698 to Appelman (Appelman) in view of U.S. Patent No. 2002/0137498 to Goss et al. (Goss) and further in

view U.S. Patent No. 6,091,948 to Carr et al. (Carr). Applicants respectfully traverse this rejection for the reasons set forth below.

A. The combination of Appelman, Goss, and Carr is improper because such a combination would produce an inoperable result.

In order to combine references, there must be some reasonable expectation of success. (MPEP § 2143.02). Applicants respectfully submit that the Examiner's proposed combination of three different forwarding methods would produce inoperable and contradicting results. Appelman teaches a call forwarding method based on the location of the mobile device. In particular, Appelman states:

Based on a detected placement of the mobile communications device in a cradle associated with the mobile communications device, a process may be initiated to forward future incoming communications directed to that mobile communications device to a second communications device. Based on a detected removal of the mobile communications device from the cradle associated with the mobile communications device, a process may be initiated to cancel forwarding of future incoming communications directed to the mobile communications device.

(Col. 1, lines 34-45; emphasis added). As such, Appelman teaches forwarding calls when the device is in the cradle and canceling the forwarding feature when the device is removed from the cradle. Goss, on the other hand, teaches automatically forwarding calls when the device is out of service. For example, Goss states:

Thus, the present invention allows a user to be more reachable because call forwarding is automatically controlled based upon the mobile phone being in or out of service at the time of a call to the mobile phone. The present invention provides for automatic call forwarding such that the user does not need to manually activate (or deactivate) call forwarding each time he or she powers off (or on) the mobile unit.

(Paragraph [0011]; emphasis added). Applicants respectfully submit that combining the forwarding features of Appelman and Goss would produce undesirable and contradicting results. For example, if a user wanted to charge the mobile device in the cradle while the device was powered on (as commonly done by users), the forwarding method of Appelman would attempt to forward incoming calls. In contrast, the forwarding method of Goss would

attempt to connect the calls in a normal manner. Thus, the forwarding methods of Appelman and Goss would contrast one another. Furthermore, if the device was powered off and not in the cradle, the forwarding method of Appelman would attempt to connect the incoming call in a normal manner and the forwarding method of Goss attempt to forward incoming calls. Such contradicting instructions would produce an inoperable result because the MSC of Goss and/or wireless communication system of Appelman would not know whether to forward the incoming calls or connect the call to the mobile device. Since MPEP § 2143.02 requires reasonable expectation of success, Applicant submits that the rejection is improper.

B. The combination of Appelman, Goss, and Carr is improper because Goss teaches away from the present application

On page 3 of the Office Action, the Examiner correctly recognized that Appelman and Goss fail to teach or suggest “generating a proposal based at least in part on second information, wherein the proposal comprises call forwarding targets ... and receiving, from the terminal, an acceptance which designates at least one or more call forward targets....,” as recited in Claim 1 and similarly recited in Claim 11. However, the Examiner asserted that Carr cured this deficiency. Applicants respectfully disagree with the Examiner’s position. In particular, Applicants submit that the rejection is improper because Goss expressly teaches away from such a feature. As discussed above, Goss states “call forwarding is automatically controlled based upon the mobile phone being in or out of service at the time of a call to the mobile phone.” (Paragraph [0011]; emphasis added). Moreover, Goss explicitly states that “[t]he present invention provides for automatic call forwarding such that the user does not need to manually activate (or deactivate) call forwarding each time he or she powers off.” (Paragraph [0011]; emphasis added). As such, Goss clearly intends for the call forwarding operation to be activated automatically when the user powers down the device. Combining the teachings of Carr would prompt “the user for activation of call forwarding each time the user powers down the wireless device.” (Col. 2 lines 1-2; emphasis added). Such a manual requirement contrasts the express teaching of Goss (with regard to no manual activation). As such, Applicant submits that the rejection is improper because Goss teaches away from prompting the user to select a forwarding destination from a proposed list of destinations.

C. The combination of Appelman, Goss, and Carr fails to teach or suggest “identifying, based at least in part on the received information, second

information regarding a period during which the terminal is to be off or without service,” as recited in Claims 1 and 11

Applicants respectfully submit that Appelman, Goss, and Carr fail to teach or suggest the above mentioned feature. In particular, Applicants submit that the Examiner improperly ignored the definition of second information. Claims 1 and 11 recite identifying, based at least in part on the received information, second information regarding a period during which the terminal is to be off or without service.” (Emphasis added). In rejecting this feature, the Examiner asserted on page 3 of the Office Action that Appelman teaches “identifying, based at least in part on the received information, second information” and that “Appelman does not particularity disclose identifying information regarding a period during which the terminal is to be off or without service.” The Examiner attempted to cure this deficiency by providing the teachings of Goss. Applicants submit that this is improper. The Examiner is essentially asserting that Appelman teaches “second information,” but not the definition of “second information.” Thus, the asserted “second information” in Appelman does not correspond to the definition recited in the claims. Instead, the asserted second information in Appelman relates to forwarding information and not “a period during which the terminal is to be off or without service,” as required by independent Claims 1 and 11.

D. The rejection based on Appelman, Goss, and Carr relies upon impermissible hindsight

Applicants further submit that the rejection is improper because the Examiner has improperly used Applicants’ disclosure as a guide to rejecting the claim. While it is understood that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, it must take into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made not include knowledge gleaned only from the Applicant's disclosure. In this instance, the motivation was gleaned from the Applicant’s disclosure because the only suggestion of record to make such a combination is found in Applicants’ own disclosure. Accordingly, Applicants submit that the rejection is improperly based on hindsight reasoning and respectfully requests withdrawal of the rejection.

II. Rejection of Claims 3, 5, 6, 8, 9, and 13-15 under 35 U.S.C. § 103(a)

In section 5 of the Office Action, Claim 3 was rejected as being unpatentable over Appelman in view of Goss in view of Carr and further in view of U.S. 2002/0102974 to Raith (Raith). In section 6 of the Office Action, Claims 9, 13, and 14 were rejected as being unpatentable over Appelman in view of Goss in view of Carr and further in view of U.S. 2004/0102188 to Boyer et al. (Boyer). In section 7 of the Office Action, Claim 8 was rejected as being unpatentable over Appelman in view of Goss in view of Carr and further in view of U.S. 6,584,188 to Kim (Kim). In section 8 of the Office Action, Claims 5 and 15 were rejected under Appelman in view of Goss in view of Carr and further in view of U.S. 2003/0140145 to Lindberg et al. (Lindberg).

Applicants note that these remaining prior art references were directed to specific limitations recited in the remaining dependent claims of the present application. However, each of these dependent claims include at least one of the deficiencies discussed above with regard to the independent claims and Applicants submit that none of these remaining prior art references cure the deficiencies discussed above.

III. Conclusion


Because none of the references cited by the Examiner, either separately or in combination with each other, teaches all of the required limitations of independent Claims 1 and 11, Applicants submit that each of these claims are patentable over this prior art. Furthermore, because dependent Claims 2-10 and 12-16 are each directly or indirectly dependent upon independent Claims 1 and 11, Applicants submit that each of these claims are allowable for at least the same reasons as discussed above.

Respectfully submitted,

Date 5/23/08

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